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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,819

11/13/2006

Axel Burmeister

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4325

27384 7590 03/11/2008  
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EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,819	<b>Applicant(s)</b> BURMEISTER, AXEL	
	<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 102(b) rejection of claims 1-9 as anticipated by Takeuchi et al. of record in the previous Office Action mailed 6/8/2007, Pages 2-3, Paragraph #2 has been withdrawn due to the Applicant's amendment filed 12/10/2007.

### ***Claim Objections***

2. Claim 2 is objected to because of the following informalities: The word "polymers" should be inserted after "comprises" and before "which" in order to read correctly as it was previously recited in claim 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation "producing areas of varying degrees of darkness and lightness" in new claims 10 and 11 is deemed new matter. Applicant has support for "varying degrees of lightness" on page 1, lines 28-29 of the Specification, but there is no support found in the Specification for "varying degrees of darkness and lightness". Thus, the specification does not provide support for

this new limitation. Therefore, the limitation “producing areas of varying degrees of darkness and lightness” in new claims 10 and 11 is deemed new matter.

Furthermore, the recitation “selectively varied” in new claim 11 is deemed new matter. The specification does not provide support for this new limitation. The specification has support for the “at least one layer, varying locally in thickness” (see page 1, lines 34-35 of the Specification), but no support is found for the at least one layer being “*selectively* varied locally in its thickness”, as recited in new claim 11. Thus, the new recitation “selectively varied” is deemed new matter.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonza et al. (US 6,737,154 B2).

7. Regarding claim 1, Jonza et al. teach a coated transparent plastic film comprising a plastic film (Figs. 12, 15, 16 and 18, layer 602, 604, 606 or 608) and at least one layer applied to the plastic film (Figs. 12, 15, 16 and 19, layer 606, 616 and 618), wherein the at least one layer varies locally in thickness in order to form an image (Figs. 12, 15, 16 and 18-20, element 610; col. 15, lines 59-60).

8. Regarding claims 2 and 8, note the at least one layer comprises polymers which can be colored (col. 13, line 62-col. 14, line 4).
9. Regarding claim 3, note the layer is formed from blended polymers (col. 6, lines 28-30).
10. Regarding claims 4 and 9, note at least one layer is self-adhesive (col. 11, lines 42-67; and Fig. 18, layer 638).
11. Regarding claim 5, note the self-adhesive layer is inherently designed such that its structure is destroyed when the layer is detached from an attachment surface, since the adhesive can include a natural rubber composition (col. 11, line 53), which is the same to that of the adhesive disclosed in Applicant's present application.
12. Regarding claim 6, note the layer comprises ultraviolet pigments (col. 13, line 61 to col. 14, line 4).
13. Regarding claim 7, note the method of applying to the transparent plastic film (Figs. 12, 15, 16 and 18, layer 602, 604, 606 or 608) the at least one layer (Figs. 12, 15, 16 and 19, layer 606, 616 and 618) with a locally varying layer thickness in order to depict an image by means of the varying layer thickness (Figs. 12, 15, 16 and 18-20, element 610).
14. Regarding claim 10, Jonza et al. teach a coated transparent plastic film comprising a plastic film (Figs. 12, 15, 16 and 18, layer 602, 604, 606 or 608) and at least one layer applied to the plastic film (Figs. 12, 15, 16 and 19, layer 606, 616 and 618), wherein the at least one layer varies locally in thickness producing areas of varying degrees of darkness and lightness in the at least one layer thereby forming an image (Figs. 12, 15, 16 and 18-20, element 610; col. 15, lines 59-60).
15. Regarding claim 11, Jonza et al. teach a method of producing an image on a transparent plastic film comprising applying to the transparent plastic film (Figs. 12, 15, 16 and 18, layer

602, 604, 606 or 608) at least one layer (Figs. 12, 15, 16 and 19, layer 606, 616 and 618) that is selectively varied locally in its thickness producing areas of varying degrees of darkness and lightness thereby forming an image (Figs. 12, 15, 16 and 18-20, element 610; col. 15, lines 59-60).

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection, which is presented above.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine Simone/  
Examiner, Art Unit 1794

/KEITH D. HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794